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OFFICE OF PETITIONS

In re Application of
Jensen et al.
Application No. 09/839,433
Filed: April 20, 2001
Attorney Docket No. 10209.56

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: DECISION ON PETITION
: UNDER 37 CFR 1.78(a)(3)
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This is a decision on the petition under 37 CFR 1.78(a)(3), filed December 17, 2010, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to the prior-filed nonprovisional applications set forth in the amendment filed concurrently with the instant petition.

The petition is **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application(s), unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant petition does not comply with item (1) above with regards to nonprovisional Application Nos. 09/384,785 and 09/523,865 since there are no common inventors with the instant application. As discussed in MPEP 201.11, the later-filed application must be filed by an inventor or inventors named in the prior-filed application for a benefit claim under 35 U.S.C. 120. There are no common inventors in the instant application and Application No. 09/384,785 and Application No. 09/523,865.

Further, 37 CFR 1.78(a)(2)(i) requires that any nonprovisional application claiming the benefit of one or more prior-filed copending nonprovisional applications must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) and indicating the relationship of the applications. The relationship between the applications is whether the subject application is a continuation, divisional, or continuation-in-part of a prior-filed nonprovisional application. An example of a proper benefit claim is: "This application is

a continuation of Application No. 10/---, filed---." A benefit claim that merely states: This application claims the benefit of Application No. 10/---, filed---," does not comply with 37 CFR 1.72(a)(2)(i) since the proper relationship, which includes the type of continuing application, is not stated. Also, the status of each nonprovisional parent application (if it is patented or abandoned) should also be indicated, following the filing date of the parent nonprovisional application. See Manual of Patent Examining Procedure, 8th ed., August 2001), Section 201.11, Reference to First Application. The amendment filed December 17, 2010 fails to state the relationships of all the applications listed to the instant application.

If petitioner merely wishes the applications listed as co-pending applications, a petition under 37 CFR 1.78 is not necessary and a refund of the petition fee maybe requested. 37CFR 1.78 is only necessary when claiming the benefit of the prior applications.

Finally, petitioner has requested benefit of Application No. 09/384,785 filed on August 27, 1999 and issued as Patent No. 6,214,351 on April 10, 2001. Since the instant application was filed on April 20, 2001, no copendency exists between these two applications. Copendency between the instant application and the prior application is required. Since the applications are not copending, the benefit claim to the prior-filed nonprovisional is improper. Applicant is required to delete the reference to the prior-filed application from the first sentence(s) of the specification, unless applicant can establish copendency between the applications.

Accordingly, before the petition under 37 CFR 1.78(a)(3) can be granted, a substitute amendment¹ correcting the above matters, along with a renewed petition under 37 CFR 1.78(a)(3), is required. No further petition fee is necessary.

Further correspondence with respect to this matter should be addressed as follows:

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Any questions concerning this matter may be directed to Joan Olszewski at (571) 272-7751.

/Liana Walsh/
Liana Walsh
Petitions Examiner
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¹ Note 37 CFR 1.121